

PATENT APPLICATION
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of

Docket No: Q78605

Akiyoshi CHOSOKABE

Appln. No.: 10/726,612

Group Art Unit: 3714

Confirmation No.: 5767

Examiner: Tramar Yong HARPER

Filed: December 4, 2003

For: GAME DEVICE, GAME CONTROL METHOD AND PROGRAM

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.37, Appellant submits the following:

Table of Contents

I. REAL PARTY IN INTEREST	2
II. RELATED APPEALS AND INTERFERENCES.....	3
III. STATUS OF CLAIMS	4
IV. STATUS OF AMENDMENTS	5
V. SUMMARY OF THE CLAIMED SUBJECT MATTER	6
VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL	8
VII. ARGUMENT	9
CLAIMS APPENDIX.....	18
EVIDENCE APPENDIX:.....	22
RELATED PROCEEDINGS APPENDIX	23

I. REAL PARTY IN INTEREST

The real parties in interest are KONAMI CORPORATION and KONAMI COMPUTER ENTERTAINMENT by virtue of an assignment executed by Akiyoshi Chosokabe (hereinafter “Appellant”) on November 5, 2003 and recorded in the U.S. Patent and Trademark Office on December 4, 2003 at Reel 014766 and Frame 0814.

II. RELATED APPEALS AND INTERFERENCES

Upon information and belief, there are no other prior or pending appeals, interferences or judicial proceedings known to Appellant's Representative or the Assignee that may be related to, be directly affected by, or have a bearing on the Board's decision in the Appeal.

III. STATUS OF CLAIMS

Claims 1-14 are pending and are the basis of this Appeal.

Claim 1-14 stand rejected. All of the claims pending in the present application are set forth in their entirety in the Claims Appendix, accompanying this Brief on Appeal.

IV. STATUS OF AMENDMENTS

The claims have not been amended subsequent to the Final Office Action of July 17, 2007. Accordingly, all amendments to the claims, which have been made during prosecution of the present application, have been entered and are reflected in the accompanying Claims Appendix. However, Appellants note that in the Advisory Action dated October 25, 2007, the Examiner held that the Request for Reconsideration under 37 C.F.R. § 1.116 filed by Appellant on October 16, 2007 would not be entered, notwithstanding that there were no requested claim amendments and no new issues raised.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

The present invention relates to a game device for controlling a game executed in a game field. (E.g., Original Specification at p. 1, ll. 1-2.)

A. Claim 1

Independent claim 1 is directed to “[a] game device for controlling a game executed inside a game field.” (E.g., Id. at p. 2, ll. 14-22; Figs. 1, 4.) Claim 1 comprises “game processing means for carrying out processing of game content executed inside the game field based on player operations;” (E.g., Id. at p. 4, l. 25 – p. 5, l. 11) “composition ratio changing means for changing one or more image composition ratios;” (E.g., Id. at p. 8, l. 13 – p. 10, l. 10; p. 12, l. 14 – p. 14, l. 12) and “display means, for generating a composite image composed of a plurality of image data based on the image composition ratios, and displaying the composite image on the surface of a substantially planar game field” (E.g., Id. at p. 12, l. 14 – p. 14, l. 12; Figs. 4-5C).

B. Claim 4

Independent claim 4 is directed to “[a] game control method for controlling a game executed in a game field, using a computer.” (E.g., Id. at p. 3, ll. 7-16.) Claim 4 comprises “processing game content executed in a game field based on player operations, using game processing means of the computer;” (E.g., Id. at p. 4, l. 25 – p. 5, l. 11) “changing one or more image composition ratios, using composition ratio change means of the computer;” (E.g., Id. at p. 8, l. 13 – p. 10, l. 10; p. 12, l. 14 – p. 14, l. 12) and “generating a composite image that is a combination of a plurality of image data based on the image composition ratios and displaying a

surface of a substantially planar game field using the composite image, using image display means of the computer” (E.g., Id. at p. 12, l. 14 – p. 14, l. 12; Figs. 4–5C).

C. Claim 5

Independent claim 5 is directed to “[a] computer readable storage medium storing a program to execute control of a game carried out in a game field, in a computer, the program causing the computer to execute the steps.” (E.g., Id. at p. 3, ll. 17-25.) Claim 5 comprises “processing game content executed in the game field based on player operations;” (E.g., Id. at p. 4, l. 25 – p. 5, l. 11) “changing one or more image composition ratios;” (E.g., Id. at p. 8, l. 13 – p. 10, l. 10; p. 12, l. 14 – p. 14, l. 12) and “generating a composite image that is a combination of a plurality of image data based on the image composition ratios and displaying a surface of a substantially planar game field using the composite image” (E.g., Id. at p. 12, l. 14 – p. 14, l. 12; Figs. 4–5C).

D. Claim 6

Independent claim 6 is directed to “[a] method for texturing a surface.” (E.g., Id. at p. 3, ll. 3-16.) Claim 6 comprises “calculating, for each texture of a plurality of textures, a composition ratio based on information relating to a view of said surface;” (E.g., Id. at p. 8, l. 13 – p. 10, l. 10;) “combining said plurality of textures according to said composition ratio to create a surface texture;” (E.g., Id. at p. 12, l. 14 – p. 14, l. 12) and “storing said surface texture.” (E.g., Id.).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Whether claims 1-14 comply with the written description requirement so as to be patentable under 35 U.S.C. § 112, first paragraph.

B. Whether the amendment to the specification filed on February 13, 2007 adds new matter to the present disclosure, and is therefore objectionable under 35 U.S.C. § 132(a).

For the purposes of this appeal, independent claims 1, 4, 5, and 6, and the claims dependent thereon, stand together.

Appellant further notes that the Examiner's rejection of claims 1-5 under 35 U.S.C. § 102(b) as allegedly being anticipated by Iwase (5,616,079) and the Examiner's rejection of claims 1-5 under 35 U.S.C. § 102(b) as allegedly being anticipated by Yamazaki et al. (6,280,323) in the first Office Action dated November 13, 2006 have been overcome by the arguments and amendments made in the Amendment under 37 C.F.R. § 1.111 filed on February 13, 2007 and were not again presented in the final Office Action dated July 17, 2007. Thus, the claims are otherwise considered patentable over the prior art.

VII. ARGUMENT

A. Written Description and New Matter

Review of the questions presented under both 35 U.S.C. § 112, first paragraph, and 35 U.S.C. § 132(a) is proper in this instance, since “where the alleged new matter is introduced into or affects the claims, thus necessitating their rejection on this ground, the question becomes an appealable one, and should not be considered on petition even though that new matter has been introduced into the specification also.” MPEP § 608.04(c).

“The specification shall contain a written description of the invention.” 35 U.S.C. § 112 at ¶ 1. The requirement “that a patent contain a written description of a claimed invention [is] independent of the requirements to enable one skilled in the art to make and use the invention. Lizardtech, Inc. v. Earth Res. Mapping, Inc., 433 F.3d 1373, 77 U.S.P.Q.2d (BNA) 1391 (Fed. Cir. 2006).

“[T]he test for sufficiency of support . . . is whether the disclosure of the application relied upon ‘reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.’” Vas Cath Inc. v. Mahurkar, 935 F.2d 1555, 1563, 19 U.S.P.Q.2d (BNA) 1111, 1116 (Fed. Cir. 1991) (quoting Ralston Purina Co. v. Far Mar Co, Inc., 772 F.2d 1570, 1575, 227 U.S.P.Q. (BNA) 177, 179 (Fed. Cir. 1985)). In other words, “the applicant must . . . convey with reasonable clarity to those skilled in the art that . . . ; he or she was in possession of the invention.” Vas Cath, 935 F.2d at 1563-64.

“[I]psis verbis disclosure is not necessary to satisfy the written description requirement of section 112. Instead, the disclosure need only reasonably convey to persons skilled in the art that the inventor had possession of the subject matter in question.” Fujikawa v. Wattanasin, 93 F.3d 1559, 1570, 39 U.S.P.Q.2d (BNA) 1895, 1904 (Fed. Cir. 1996). “Identity of description is not necessary. . . . [T]he disclosure as originally filed does not have to provide in haec verba support for the claimed subject matter at issue. Identity of that which is described, however, is necessary: What is claimed by the patent application must be the same as what is disclosed in the specification” New Railhead Mfg., L.L.C. v. Vermeer Mfg. Co., 298 F.3d 1290, 1295-96, 63 U.S.P.Q.2d (BNA) 1843 (Fed. Cir. 2002); cert. denied, 537 U.S. 1232 (2003) (citations and internal quotations omitted) (emphasis modified).

Furthermore, under 35 U.S.C. § 132, “[n]o amendment shall introduce new matter into the disclosure of the invention.” See also 37 C.F.R. § 1.121(f). In applying the written description requirement of 35 U.S.C. § 112, first paragraph, the Federal Circuit has recently confirmed that “[t]he same standards govern whether new matter has been added to the specification.” In re Schiers, 2007 U.S. App. LEXIS 27630 at *7 (Fed. Cir. Nov. 29, 2007) (citation omitted).

B. The Claims Are Supported By The Original Specification And The Term “Composition Ratio” Does Not Introduce New Matter

In the amendment of February 13, 2007, Appellant noted the following portion of the original specification which unequivocally explains the meaning of the “composition rate” in the described exemplary embodiment:

[A] result of adding a pixel value P_0 corresponding to a pixel having the image composition rate set among the pixel values stored in the display storage section 14, to multiplication pixel value P_1 having composition rate set times image composition rate σ_1 , that is a value of $P_0 + P_1 \times \sigma_1$, is set as a new pixel value.

...

In this way, the display control section 34 can generate composite (blended) image data of the first pattern image data and the second pattern image data blended according to a positional relationship between the first model and the second model, and image composition rate setting, and display this composite image.

(Original Specification at 12, 13 (emphasis added.))

Having considered the above-quoted portions of the original specification, it would be clear to one of ordinary skill in the art that, although the described value σ_1 might more commonly be referred to as a “ratio” rather than a “rate,” according to which the values P_0 and P_1 are “composed” or “blended,” one of ordinary skill in the art would recognize that these terms are closely related in meaning and etymology. Moreover, there could be no confusion to one of ordinary skill in the art regarding what either the term “composition rate” or “composition ratio” refer to, as the above-quoted mathematical expression quite clearly indicates that the value σ_1 is the “composition rate” in the described exemplary embodiment.

Furthermore, the mathematical expression indicates that P_1 is multiplied by the scaling factor σ_1 , and that P_0 is added to the result of this multiplication. Thus, P_0 and P_1 are by definition “composed” in a “ratio.” The mathematical expression, thus, clearly indicates that the value σ_1 may naturally be referred to as the “composition ratio” for the “composed” values. This is supported by the subsequent portion of the above-quoted portion of the original specification,

which states that “composite (blended) image data” is generated by blending two sets of image data “according to . . . [the] image composition rate setting.”

Thus, by the disclosure of the exemplary embodiments described in the above-quoted portions of the original specification, Appellant clearly indicated to those of ordinary skill in the art Appellant’s possession of the subject matter claimed in amended independent claims 1, 4, 5, and 6, including the matter referred to by the term “composition ratio.” Since the underlying meaning of the term “composition ratio” was clearly disclosed in the original specification, and since “ipsis verbis disclosure is not necessary to satisfy the written description requirement,” the fact that the exact term “composition ratio” did not occur in the original specification is insufficient to vitiate Appellant’s satisfaction of the written description requirement in this instance. Only “[i]dentity of that which is described . . . is necessary;” since the matter referred to by the term “composition ratio” is identical to that of the original disclosure, the written description requirement is met. Thus, the change of “rate” to “ratio,” introduced no new matter to the disclosure.

C. The Final Office Action of July 17, 2007 and the Advisory Action of October 25, 2007 Misinterpret Appellant’s Specification

Notwithstanding the above, in the Final Office Action of July 17, 2007 and the Advisory Action of October 25, 2007, the Examiner makes a number of unsupported contentions.

The Examiner, appears to misread portions of the Specification quoted by Appellant in the amendment of February 13, 2007. The original specification described an exemplary embodiment of the invention as follows:

[T]he display control section 34 can generate composite (blended) image data of the first pattern image data and the second pattern image data blended according to a positional relationship between the first model and the second model, and image composition rate setting, and display this composite image.

(Original Specification at 13.)

The Examiner contends that this portion of the original Specification indicates that an “image composition rate” as described in the phrase “image composition rate setting” is different from the described “composite (blended) image data of the first pattern image data and the second pattern image data.” Appellant would respectfully submit that this interpretation is not possible, and that this passage would not be so read by one of ordinary skill in the art.

The above-quoted portion of the original specification describes what “the display control section 34 can generate.” What is generated is “composite (blended) image data of the first pattern image data and the second pattern image data.”

The quoted paragraph goes on to describe how this “composite (blended) image data” is generated, by explaining that it is generated “according to a positional relationship between the first model and the second model, and image composition rate setting.” Thus, the “composite (blended) image data” is generated “according to” at least two factors, one of which is an “image

composition rate setting.” Finally, this portion states that “the display control section 34” can also “display this composite image.”

It would be immediately apparent to one of ordinary skill in the art that the “image composition rate setting” is a setting which is a factor in how the “composite image” is composed. Thus, the term “image composition rate setting” in this context would clearly be understood to refer to a setting related to the ratio or proportion in which “the first pattern image data and the second pattern image data [are] blended,” i.e., a setting with respect to how the “composite (blended) image data” is composed. Accordingly, as set forth above, the change of “composition rate” to “composition ratio” does not add new matter to the specification or the claims.

D. The Advisory Action of October 25, 2007 Misinterprets Appellant’s Arguments

Furthermore, in the Advisory Action of October 25, 2007, the Examiner contends that “the applicant attempted to overcome the prior art of record by changing the limitation rate to ratios, making it clear that the terminology changes the invention and/or scope.” Appellant, in fact, did not rely on this change in traversing any portion of the prior art of record.

For Example, in the amendment filed on February 13, 2007, Appellant stated that “the Examiner appears to have misinterpreted the term ‘composition rates’ to mean ‘changes of images’ However, the term ‘composition rate’ has been used in the specification to refer to a ratio used to compose multiple sets of image data to create a composite image.” (Amendment

of February 13, 2007 at 8.) Appellant continued by pointing out portions of the original specification which supported the change in terminology.

Appellant further stated therein that “the original specification clearly shows that the most reasonable meaning of ‘composition rate’ in the disclosed exemplary embodiments is a ratio by which first and second image data are composed to create a composite image.” (Id.) Appellant further explained that “[i]n light of the illustrative portions of the original specification . . . and in the interest of clarification, Applicant . . . amends the specification, claims, and drawings to replace the word “rate” with the word “ratio” throughout.” (Id. at 9.)

Appellant then continued by addressing the Examiner’s rejections without relying on the described change in terminology, but rather, by presenting completely unrelated deficiencies of the cited references. For example, regarding the rejection under 35 U.S.C. § 102(b) over U.S. Patent No. 5,616,079 to Iwase et al. (“Iwase”), Appellant asserted that “the cited portions of Iwase only disclose the rendering of a whole scene, whereas claim 1 requires composing image data, based on image composition ratios, to produce a composite image.” Although naturally using the amended language in referring to claim 1, this assertion goes to Iwase’s failure to disclose any composition of image data to produce a composite image.

Furthermore, regarding the rejection under 35 U.S.C. § 102(b) over U.S. Patent No. 6,280,323 to Yamazaki et al. (“Yamazaki”), Appellant asserted that “[a]lthough Yamazaki appears to show processing of texture data to be mapped to polygons, and processing of color and luminance data of the textures, Yamazaki does not appear to disclose anywhere that such a texture is a ‘composite image’ which is ‘composed of a plurality of image data based on . . .

image composition ratios,' as required by amended claim 1." Clearly, whichever terminology is used, Appellant's quoted assertion relies on Yamazaki's failure to disclose a 'composite image' composed in a manner clearly disclosed in the original specification.

Conclusion

Thus, as set forth above, Appellant's amendments to the specification and claims of the present application are fully supported by Appellant's original disclosure, and therefore fully satisfy both 35 U.S.C. § 112, first paragraph, and 35 U.S.C. § 132(a).

Moreover, since the Examiner's rejection of claims 1-5 under 35 U.S.C. § 102(b) as allegedly being anticipated by Iwase (5,616,079) and the Examiner's rejection of claims 1-5 under 35 U.S.C. § 102(b) as allegedly being anticipated by Yamazaki et al. (6,280,323) in the first Office Action dated November 13, 2006 have been overcome by the arguments and amendments made in the Amendment under 37 C.F.R. § 1.111 filed on February 13, 2007, and these rejections were not again presented in the final Office Action dated July 17, 2007, Appellant must assume that no basis exists for any further rejection based on the previously cited references of Iwase (5,616,079) and Yamazaki et al. (6,280,323).

Appellant, therefore, respectfully submits that any further rejection based on the previously cited references would be clearly improper as an example of piecemeal examination, greatly increasing the time and expense of prosecution to Appellant. Accordingly, Appellant respectfully submits that all claims of the instant application are presently allowable.

The USPTO is directed and authorized to charge any fee required under 37 C.F.R. §41.37(a) and 1.17(c) to Deposit Account No. 19-4880.

APPEAL BRIEF UNDER 37 C.F.R. § 41.37
U.S. Application No. 10/726,612

Attorney Docket No. Q78605

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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Date: January 22, 2008

CLAIMS APPENDIX

CLAIMS 1-14 ON APPEAL:

LISTING OF CLAIMS:

1. A game device for controlling a game executed inside a game field, comprising:
game processing means for carrying out processing of game content executed inside the game field based on player operations;
composition ratio changing means for changing one or more image composition ratios;
and
display means, for generating a composite image composed of a plurality of image data based on the image composition ratios, and displaying the composite image on the surface of a substantially planar game field.
2. The game device of claim 1, wherein
the game field is arranged in three-dimensional space,
the display means displays the game field based on a set viewing direction, and
the composition ratio changing means changes the image composition ratios based on at least one of the viewing direction and a set light source position.

3. The game device of claim 1, wherein the display means carries out display of the game field by arranging models to which said plurality of image data set as textures in an overlapped manner in three-dimensional space and carrying out rendering.

4. A game control method for controlling a game executed in a game field, using a computer, comprising the steps of:

processing game content executed in a game field based on player operations, using game processing means of the computer;

changing one or more image composition ratios, using composition ratio change means of the computer; and

generating a composite image that is a combination of a plurality of image data based on the image composition ratios and displaying a surface of a substantially planar game field using the composite image, using image display means of the computer.

5. A computer readable storage medium storing a program to execute control of a game carried out in a game field, in a computer, the program causing the computer to execute the steps of:

processing game content executed in the game field based on player operations;

changing one or more image composition ratios; and

generating a composite image that is a combination of a plurality of image data based on the image composition ratios and displaying a surface of a substantially planar game field using the composite image.

6. A method for texturing a surface, comprising:
calculating, for each texture of a plurality of textures, a composition ratio based on information relating to a view of said surface;
combining said plurality of textures according to said composition ratio to create a surface texture;
storing said surface texture.

7. The method of claim 6, wherein said information relating to a view of said surface comprises an angle indicating the rotation of said surface, in the plane of said surface, relative to a viewpoint position.

8. The method of claim 6, wherein said information relating to a view of said surface comprises a viewing direction.

9. The method of claim 6, wherein said information relating to a view of said surface comprises positions of one or more light sources.

10. The method of claim 7, wherein each of said plurality of textures is associated with one of a plurality of auxiliary surfaces immediately above said surface, said auxiliary surfaces having a shape identical to said surface.

11. The method of claim 7, wherein said combining said plurality of textures comprises, multiplying said textures by said composition ratio, and adding together the resulting textures.

12. The method of claim 7, further comprising causing said surface texture to be displayed as a texture of said surface.

13. The method of claim 7, wherein said surface texture is a representation of a sports field surface.

14. The method of claim 13, wherein said plurality of textures comprises a first texture comprising transparent areas and colored areas, and a second texture comprising colored areas in positions corresponding to the transparent areas of the first texture, wherein the colored areas of the first and second textures are differently shaded.

EVIDENCE APPENDIX:

Pursuant to 37 C.F.R. § 41.37(c)(1)(ix), submitted herewith are copies of any evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 or any other evidence entered by the Examiner and relied upon by Appellant in the appeal.

None.

RELATED PROCEEDINGS APPENDIX

Submitted herewith are copies of decisions rendered by a court or the Board in any proceeding identified about in Section II pursuant to 37 C.F.R. § 41.37(c)(1)(ii).

None.

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MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
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Alexandria, VA 22313-1450

Sir:

Submitted herewith please find an Appeal Brief. The statutory fee of \$510.00 is being charged to Deposit Account No. 19-4880 via EFS Payment Screen. The USPTO is also directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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